REMARKS

The above amendments and these remarks are submitted in reply to the Office Action dated April 21, 2004.

Summary of the Examiner's Objections/Rejections

Claims 1-3, 7 and 12-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schieve, et al (U.S. Patent No. 5,398,333). Claims 4-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schieve, et al. Claims 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schieve, et al. in view of Schmidt, et al. (U.S. Patent No. 6,167,482). Claims 6 and 8 stand rejected under 35 U.S.C. §112, 2nd paragraph as being indefinite. Claim 8 stands rejected under 35 U.S.C. §112, 1st paragraph.

Summary of the Applicant's Amendments

The specification has been amended to correct minor grammatical and typographical errors present therein. Claims 1-2, 7-8 and 11-13 have been amended. The Applicant submits that no new matter has been added by such amendments.

Rejection of Claims 1-3, 7 and 12-13

The Applicant traverses the rejection of the aforementioned claims for the reasons set forth in greater detail below. With respect to Claim 1, it is directed to a method for entering system firmware recovery mode by performing the following steps:

> "...detecting status of at least two software-detectable buttons at power-on of the computer system..." and
>
> "...distinguishing between normal use of the at least two software-detectable buttons and as firmware recovery buttons..."

which is not disclosed in Schieve, et al. Consequently, Schieve, et al. does not anticipate the claimed invention. As understood, Schieve, et al. discloses a system where a single (e.g. reset) button is used to reset the underlying computer system and enter a diagnostics mode depending on the number of times the reset button is depressed within a given time period (see, for example, col. 4, lines 10-15; col. 5, lines 10-15; and col. 5, lines 45-53).

Thus, the system disclosed in Schieve, et al. does not detect the status of at least two software-detectable buttons or distinguish between the normal use of the at least two buttons and as firmware recovery buttons as recited in Claim 1. Accordingly, reconsideration of the rejection of Claim 1 is respectfully requested.

Claims 2-3, 7 and 12-13 directly or indirectly depend upon and include the limitations of Claim 1 and are allowable at least for the reasons set forth above with respect to Claim 1. In addition, these claims independently define novel subject matter that is not disclosed in Schieve, et al. For example, Claim 2 recites that the "...at least two software-detectable buttons include power and sleep buttons..." Such a configuration is not disclosed in Schieve, et al. as Schieve, et al. only discloses the use of a reset button performing a series of operations. No discussion of a "sleep button" (e.g. second button) or anything analogous thereto is disclosed in Schieve, et al. Consequently, at least this claim is not anticipated by Schieve, et al.

Additionally, Claim 7 which depends upon Claim 2 includes a limitation directed to:

> "...selectively holding down the power or sleep button at power-on for a predetermined time period..."

which is also not disclosed in Schieve, et al. Consequently, such claim is not anticipated by Schieve, et al. As understood, and disclosed, for example, at col. 5, line 46 – col. 6, line 2, when the reset button is depressed, a timeout counter is set to a particular value (e.g. 200ms) within which the reset button needs to be depressed a second time to invoke the diagnostics routine; otherwise, the computer system is reset. Thus, as disclosed, for the diagnostics routine to be invoked, or otherwise executed, the reset button needs to be depressed two or more times within a given time period. Holding the reset button down for a predetermined period will not invoke the diagnostics routine. Thus, "...holding down the power or sleep button at power-on for a predetermined time period..." is not disclosed in Schieve, et al. Consequently, at least this limitation is not anticipated by Schieve, et al.

Claim 12 includes a limitation directed to "...simultaneously holding down the at least two software-detectable buttons..." which is not disclosed by Schieve, et al. As discussed in greater detail above, Schieve, et al. discloses a computer system where a

single button is used, depending upon the number of times it is depressed, to either reset the computer system or enter a diagnostics routine. The step or requirement of simultaneously holding down at least two software-detectable buttons to perform a given function is not disclosed or otherwise suggested in the reference. Consequently, this claim is not anticipated by Schieve, et al.

Claim 13 includes a limitation directed to "holding down the at least two software-detectable buttons in a predetermined sequence..." which is also not disclosed or otherwise suggested in Schieve, et al. As discussed in greater detail above, Schieve, et al. is directed to a single (e.g. reset) button capable of invoking two functions depending upon how many times the reset button is depressed within a given time interval. There is no discussion within Schieve, et al. of depressing or holding down two or more buttons in a predetermined sequence as defined in Claim 13. Consequently, Claim 13 is not anticipated by Schieve, et al. Accordingly, reconsideration of the rejection of Claims 1-3, 7 and 12-13 is respectfully requested.

Rejection of Claims 4-5

The Applicant traverses the rejection of the aforementioned claims for the reasons set forth in greater detail below. Claims 4-5 indirectly depend upon and include the limitations of Claim 1 and are thus allowable at least for the reasons set forth above with respect to Claim 1. Accordingly, reconsideration of the rejection of Claims 4-5 is respectfully requested.

Rejection of Claims 9-11

The Applicant traverses the rejection of the aforementioned claims for the reasons set forth in greater detail below. Claims 9-11 depend upon and include the limitations of Claim 1 and are allowable at least for the reasons set forth above with respect to Claim 1. Additionally, adding the teachings of Schmidt, et al. to the teachings of Schieve, et al. still does not render the aforementioned claims obvious as Schmidt, et al. does not overcome the aforementioned shortcomings of Schieve, et al. More specifically, like Schieve, et al., Schmidt, et al. does not teach or suggest:

> "...detecting status of at least two software-detectable buttons at power-on of the computer system..." and
>
> "...distinguishing between normal use of the at least two software-detectable buttons and as firmware recovery buttons..."

In fact, the use or status of at least two software-detectable buttons in maintaining accurate unit timing is not disclosed in Schmidt, et al. Thus, combining Schieve, et al. with Schmidt, et al. does not render the invention as defined in Claims 9-11 obvious. Accordingly, reconsideration of the rejection of Claims 9-11 is respectfully requested.

Rejection of Claims 6 and 8

The Applicant traverses the rejection of the aforementioned claims for the reasons set forth in greater detail below. With respect to Claim 6, it depends upon Claim 2 which has been amended to recite that "...the software-detectable buttons include power and sleep buttons..." Thus, the Applicant submits that Claim 2 provides sufficient antecedent basis for the limitation "...both the power button and the sleep button..." recited in Claim 6 as Claim 2 is not necessarily limited to the use of only a single button. Multiple buttons may be used and fall within the scope of Claim 2. Accordingly, reconsideration of the rejection of Claim 6 is respectfully requested.

With respect to the rejection of Claim 8 under 35 U.S.C. §112, first paragraph, the Applicants submit that one of ordinary skill in the art, after reviewing the specification would be provided with enough information to make a determination without excess effort or research that a platform-specific button may be any button on a particular platform that may be used, by itself or in combination with other buttons, to initiate entry into the firmware recovery mode. There is no restriction present within the specification regarding what button or series of buttons may be employed to perform such functionality. As described, for example, on page 8, lines 1-4:

> "...Other embodiments of the present invention may include a plurality of buttons that are held down simultaneously or that are sequentially held down in a predetermined sequence. These buttons and/or the sequence must each be detectable. Such is the case when using the sleep and power button together. Other preferred embodiments of the present invention may use a button other than the power button (such as the sleep button or platform specific button)..."

Thus, all that is required is that the platform-specific button selected be held down or depressed for a predetermined period of time, or that the platform-specific button be used in conjunction with one or more buttons in a specific sequence or manner. Thus, the specification provides sufficient functional information to allow one of ordinary skill in the art to establish and select a platform-specific button to be used as the firmware recovery mode initiation button for a given platform. Accordingly, reconsideration of the rejection of Claim 8 under 35 U.S.C. §112, 1st paragraph is respectfully requested.

With respect to the rejection of Claim 8 under 35 U.S.C. §112, 2nd paragraph, the Applicant would like to point out that such claim has been amended to be dependent upon Claim 2, which has been amended to recite that "...the software-detectable buttons include power and sleep buttons..." Thus, the Applicant submits that Claim 2 provides sufficient antecedent basis for the limitation "...both the power button and the sleep button..." recited in Claim 8 as Claim 2 is not limited to the use of only a single button. Multiple buttons may be used and fall within the scope of Claim 2. Accordingly, reconsideration of the rejection of Claim 8 under 35 U.S.C. §112, 2nd paragraph is respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that Claims 1-13 are now in proper condition for allowance and such action is earnestly solicited.

The Commissioner is hereby authorized to charge any underpayments or credit any over payments to Deposit Account No. **16-1520** for any payment in connection with this communication, including any fees for extension of time, which may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,
PHOENIX TECHNOLOGIES LTD.

Date: 10/21/04

By: _____
Loren H. McRoss
Registration No. 40,427

915 Murphy Ranch Road
Milpitas, CA 95035
PH: (408) 570-1000
FX: (408) 570-1044